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IN THE

Supreme Court of the United States

October Term, 1957

No. 711

PETROCARBON LIMITED, *Petitioner,*

v.

ROBERT C. WATSON, Commissioner of Patents,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered in the above entitled case on July 3, 1957.

OPINIONS BELOW

The opinion of the Board of Appeals of the United States Patent Office (R. 48) is unreported and is printed in Appendix B hereto, *infra,* p. 2a; its opinion on reconsideration (R. 53), also unreported, is

likewise printed in Appendix B hereto, *infra*, p. 8a. The memorandum of the District Court (R. 55) also is unreported and is printed in Appendix B hereto, *infra*, p. 9a. The opinion of the Court of Appeals (R. 61), is printed in Appendix B hereto, *infra*, p. 11a, and is reported at 247 F. 2d 800.

JURISDICTION

The judgment of the Court of Appeals was entered on July 3, 1957; R. 66; *infra*, p. 15a. On July 18, 1957, within the period provided by the rules of the Court of Appeals, petitioner filed its motion (R. 67) to extend the time for filing a petition for rehearing. This motion was granted by order of the Court of Appeals dated July 29, 1957 (R. 71) and the time for filing the petition was thereby extended until July 29, 1957. A petition for rehearing (R. 72) was filed July 29, 1957, and was denied October 9, 1957 (R. 82). The jurisdiction of this Court is invoked under 28 U.S.C., Section 1254 (1).

QUESTIONS PRESENTED

Title 35, United States Code, Section 112 (*infra*, p. 1a), provides that a patent specification shall contain a description of the invention that is sufficient to enable a person skilled in the art to make and use the invention. Title 35, United States Code, Section 145 (*infra*, p. 1a), provides that any "applicant dissatisfied with the decision of the Board of Appeals" of the Patent Office may "have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia". The Fifth Amendment to the Constitution of the United States (*infra*, p. 1a) provides that no person shall be deprived of property without due process of law.

This case presents the following questions dealing with the interpretation and application of these statutes and of the Fifth Amendment:

1. Can the sufficiency of a patent specification to meet the statutory test of 35 U.S.C. 112 of enabling a person "skilled in the art" to make and use an invention in the field of chemistry properly be determined without taking into account the knowledge of those skilled in the chemical art to which chemical art the invention pertains?

2. Can the meaning and connotations of terms in a chemical patent specification be determined as matters of law contrary to and with the exclusion of proffered testimony of persons skilled in the art and in conflict with previous applications of 35 U.S.C. 112 by this Court?

3. Is the complainant in a civil action under 35 U.S.C. 145 against the Commissioner of Patents afforded the remedy intended by said Section 145 when the District Court refuses to hear complainant's proffered testimony of persons skilled in the art to which the invention pertains (i.e., the chemical art in this case) as to the meaning of terms and the disclosure of an application which has been questioned by the Patent Office Board of Appeals?

4. In a *de novo* action under 35 U.S.C. 145 to review a quasi-judicial administrative ruling made by the Patent Office without hearing evidence, does the refusal of the District Court to hear and consider the evidence of those skilled in the art deprive an applicant for a patent of property without due process of law?

STATUTES INVOLVED

The statutory provisions involved, comprising the pertinent portion of Section 112 and Section 145 of Title 35, United States Code, and also the Fifth Amendment to the Constitution, are printed in Appendix A, *infra*, p. 1a.

STATEMENT

On September 8, 1948, one Michael Mojzesz Szwarc, a British subject and petitioner's assignor, filed an application for patent in the U. S. Patent Office, Serial No. 48,339, entitled "Production of New and Useful Polymers". This application was based on a British application which has since matured into a British patent (R. 11). Briefly stated, the Szwarc process consisted in pyrolyzing an aromatic hydrocarbon in the vapor state whereby a solid polymer is formed and deposited on a cool surface in the form of a film of polymer (R. 24; 26; and 28, claims 7 and 16). The polymer material is described as having great thermal stability, as being resistant to attack by acid and solvents, etc. (R. 26, 27).

Ultimately certain claims of this application were held to define invention over the prior art, but the entire application was finally rejected on the ground that the description of the invention summarized above did not satisfy the requirements of Title 35, United States Code, Section 112. The decision of the Board of Appeals (*infra*, p. 2a) was rendered January 29, 1954, and its decision on rehearing (*infra*, p. 8a) was rendered March 18, 1954. Petitioner then filed suit on April 15, 1954, against the Commissioner of Patents in the United States District Court for the District of Columbia. Jurisdiction of the District

Court was invoked under Section 145 of Title 35, United States Code.

During opening statements at the hearing, the District Court refused to hear testimony bearing on the question of whether the specification conformed with the statute (R. 7, 12). A copy of the Szwarc application was received in evidence, and certain physical exhibits were accepted which demonstrated useful results obtained with the Szwarc process, as conceded at the hearing before the Court of Appeals (*infra*, p. 13a). But the District Court declined to hear the proffered testimony of persons skilled in the art who would have testified that the Szwarc description was sufficient to enable them to make and use the invention, that the meaning of its terms and its disclosure were clear to those skilled in the art, and that, to them as persons skilled in the art, Szwarc's description of a deposited film and of the properties of the material connoted obvious practical uses. After thus refusing to hear petitioner's witnesses, the District Court dismissed the complaint on the ground that there was no clear proof of mistake by the Patent Office (*infra*, p. 10a).

The Court below affirmed the dismissal of the complaint by a two-to-one decision (infra, p. 11a). The majority admitted that the case was "a difficult one", but since in their view the indications "from the face of the specification" were not sufficient "to enable readers of the application to understand how the product is to be used", the majority held that the specification was defective "as a matter of law". This view was based on the opinion of the majority that the term "film" did not connote any particular use because the specification did not say whether the deposited film

adhered to the surface on which it formed, or fell off, etc. The majority further stated that under these circumstances, "it was not possible for the plaintiff to remedy the defects in its specification by offering testimoney in its *de novo* action in the District Court".

The opinion of the dissenting Judge called attention to the language of 35 U.S.C. 112, and to the offer of proof by persons skilled in the art of what they understood to be the meaning of the terms and disclosure in the specification, and asserted that such expert testimony should have been received and evaluated in determining the sufficiency of the description to meet the statutory requirements before deciding the case.

REASONS FOR GRANTING WRIT

(1) Clearly, the above questions are of general and fundamental importance in the administration of the United States patent laws. Some 75,000 patent applications are currently being filed each year in the United States Patent Office. In general, each is written in the terms of the art to which the invention pertains, and once filed, can seldom be amplified because of Patent Office rules against "new matter" (R. 10). Unless the sufficiency of the description is to be measured by the understanding of persons skilled in the art, the inventor who files a description that is full and complete to himself and other persons skilled in the art may lose his right to a patent simply because the description is not completely comprehended by other persons not familiar with the terms of the art.

These risks face not only inventors who are citizens of the United States, but also foreign inventors and often their U. S. assignees. Most foreign countries are members of the International Convention for the

Protection of Industrial Property, pursuant to which Section 119 of Title 35, U.S.C., gives to U. S. applications of foreign inventors the benefit of the earlier filing dates of their foreign applications, provided certain conditions are satisfied among which is the requirement that the U. S. application must be for "the same invention" as the foreign application. To make sure of meeting this requirement, Szwarc followed the usual practice of filing a copy of his British application in the United States, but the disclosure of the invention which was sufficient to support the grant of the foreign patent was held insufficient in this country to inform persons skilled in the art how to make and use the invention.

It is plainly in the public interest that all of the standards of adequacy for a patent specification should be clearly and unequivocally defined so as to guide inventors in meeting the requirements of the law. Congress established the present statutory standard when it enacted Section 112, namely, that the description shall be sufficient to enable a *person skilled in the art* to make and use the invention. This standard has been part of the patent laws for many years, having been embodied in essentially the same language in the Act of 1870, 16 Stat. 201.

Thus the sufficiency of the description is essentially a question of fact as to which the applicant is entitled to be heard. The majority of the Court below reached its conclusion as a matter of law, however. The majority opinion purports to follow the decision of the Court of Customs and Patent Appeals in *In re Bremner et al.*, 182 F. 2d 216, but the latter case said merely that the law required an "indication" of the use or uses intended, and to require an indication sufficient

for a person skilled in the art is merely to restate Section 112. The majority opinion below goes further. It holds that an indication must be given to enable "readers" of the application to understand how the product is to be used, yet it endorses the refusal of the District Court to hear the testimony of persons skilled in the art that the application does furnish such an indication to them.

If these "readers" are not the persons skilled in the art mentioned in Section 112, who are they? By whom is the sufficiency of a description to be judged? The public interest requires that these questions be answered authoritatively by this Court, for the guidance of inventors, the Patent Office, and the lower courts.

(2) Section 112 clearly makes the sufficiency of the specification a question of fact, determinable according to the understanding of the description by persons skilled in the art.

As said in *Loom Co.* v. *Higgins,* 105 U.S. 580, 586, "it is easy to conceive that its meaning may be plain to those for whose use it is intended", and "as it cannot be expected that the court will possess the requisite knowledge for this purpose, it becomes necessary that it should avail itself of the light furnished by the evidence to enable it to understand the terms used in the patent and the devices and operations described or alluded to herein."

These are the established guiding principles which should have been followed in this case and which should now be reaffirmed for the general guidance of the public, of the Patent Office, and of the courts.

The majority opinion of the Court below, however, makes the sufficiency of the description a matter of law,

to be determined from the face of the description without testimony from persons skilled in the art. Not only is this holding inconsistent with the intent of the statute, but it is manifestly unfair to petitioner and to others who may be in the same situation in the future. The reason is that the record considered by the Court in such a case will contain the adverse opinions of the Patent Office as to the sufficiency of the specification, which the petitioner will be denied an opportunity to traverse. With due respect to the Patent Office staff, its members are not above mistakes and their opinions should be rebuttable.

Also the decision of the majority of the Court below is at least inconsistent with, if not in direct conflict with, a long line of decisions by this Court in which Section 112 and its predecessors have been construed. It has been held many, many times, as in *Loom Co.* v. *Higgins, supra,* that the description is sufficient if it is expressed in terms intelligible to and understood by persons skilled in the art and is sufficient to guide them to the successful application of the invention, although it may leave something to the understanding of persons skilled in the art (see also, for example, *Seabury* v. *Am Ende,* 152 U.S. 561, 567; *Minerals Separation, Ltd.* v. *Hyde,* 242 U.S. 261, 271). As already noted, *Loom Co.* v. *Higgins* pointedly observed that the Court would need "the light furnished by the evidence" of those skilled in the art in order to understand fully the terms used in the patent. This is especially true in cases of chemical nature.

The possibility is extremely remote that the point presented here will ever be reviewed by any other Court of Appeals. This is so because the Commissioner of

Patents accepts service only in the jurisdiction of his official residence, i.e., in the District of Columbia. Thus there is no way, practically speaking, of obtaining a review of the questions presented by this petition, except as this Court may decide to consider them.

(3) The refusal of the District Court to hear the proffered evidence in this case denies to petitioner the very remedy that Section 145 was intended to preserve, according to pertinent decisions of this Court. The history of this enactment is set forth in *Hoover Co.* v. *Coe*, 325 U.S. 79. After discussing previous statutes, the Court said that the 1927 revision of the law showed that (p. 87)

> "Congress decided not to do away with either, but to allow an applicant 'to have the decision of the Patent Office reviewed either by the court of appeals or by filing a bill in equity, but not both.' It is evident that no alteration in respect of the rulings which could be reviewed was intended; but the number of possible appeals was to be reduced, while saving to litigants the option of producing new evidence in a court, by retaining the equity procedure."

The Court further said, with reference to the purpose of the law (pp. 87-88):

> "Thus it is clear that throughout more than a century Congress has for correction of erroneous adverse rulings, which if unreversed would end the proceedings in the Patent Office, preserved the remedy by bill in a District Court either as additional to or alternative to that by summary appeal and has made the effect of adjudication in equity the same as that of decision on appeal."

The present case, which as already pointed out establishes practically a rule of law governing future suits

under Section 145, will have the effect of depriving applicants for patent of "the option of producing new evidence in a court", insofar as rulings on the sufficiency of a specification are concerned, an option which this Court has held the statute was intended to save. The rejection of proffered testimony is tantamount to a rejection of the responsibility placed on the courts by the statute, namely, to afford such applicants "the remedy by bill in a District Court" to review such erroneous adverse rulings in the Patent Office, which Congress has preserved throughout more than a century, as this Court has also pointed out.

(4) Petitioner further submits that the rejection of petitioner's proffered testimony results in deprivation of property without due process of law and violates the Fifth Amendment.

Of course, the decision of the question of sufficiency of the Szwarc description has been entrusted by statute to the Patent Office, in the first instance, without provision for testimony on behalf of complainant. Yet, as this Court had occasion to observe in *Morgan* v. *United States,* 304 U.S. 1, pp. 14-15,—

> "The first question goes to the very foundation of the action of administrative agencies entrusted by the Congress with broad control over activities which in their detail cannot be dealt with directly by the legislature. The vast expansion of this field of administrative regulation in response to the pressure of social needs is made possible under our system by adherence to the basic principles that the legislature shall appropriately determine the standards of administrative action and that in administrative proceedings of a quasi-judicial character the liberty and property of the citizen shall be protected by the rudimentary require-

ments of fair play. These demand 'a fair and open hearing,'—essential alike to the legal validity of the administrative regulation and to the maintenance of public confidence in the value and soundness of this important governmental process. Such a hearing has been described as an 'inexorable safeguard.'"

Thus as a general rule, the quasi-judicial determination of an issue of fact such as the meaning of the Szwarc specification to persons skilled in the art, without any opportunity for petitioner to present evidence on that question would amount to a denial of due process of law (C.J.S., Vol. 16A, Sec. 628(2)). Section 145 of Title 35, U. S. Code, provides the safeguard which prevents this obnoxious result. As said by this Court in *Bourjois, Inc.* v. *Chapman, et al.*, 301 U.S. 183, 189:—

"And neither constitution requires that there must be a hearing of the applicant before the board may exercise a judgment under the circumstances and of the character here involved. The requirement of due process of law is amply safeguarded by § 2 of the statute, which provides:

'From the refusal of said department to issue a certificate of registration for any cosmetic preparation appeal shall lie to the superior court in the county of Kennebec or any other county in the state from which the same was offered for registration.'

Compare Hagar v. Reclamation District No. 108, 111 U.S. 701, 711, 712; Hall v. Geiger-Jones Co., 242 U.S. 539, 554; Bragg v. Weaver, 251 U.S. 57, 59; Phillips v. Commissioner, 283 U.S. 589, 597; State v. McCann, 59 Me. 383, 385; Bennett v. Davis, 90 Me. 102, 106; 37 Atl. 864; McInnes v. McKay, 127 Me. 110, 116; 141 Atl. 699; 279 U.S. 820."

The *de novo* action under 35 U.S.C. 145 should provide this necessary safeguard, but the refusal to hear evidence relegates petitioner to a final decision without a hearing, on the basis of the Patent Office record including the opinions of the Patent Office personnel, but with no opportunity for petitioner to traverse these opinions by evidence of persons skilled in the art. The adverse ruling of the Patent Office, and what amounts to its summary affirmance by the lower courts, thus deprives petitioner of its patent application filed September 8, 1948 and its rights based thereon without due process of law and violates the Fifth Amendment.

True, Szwarc was a British subject and filed his first application in Great Britain. But the International Convention for the Protection of Industrial Property, to which both Great Britain and the United States have subscribed for 70 years, guarantees to Szwarc the enjoyment of the same rights as citizens of the United States. Not only for the sake of good international relations, but also to carry out the provisions of the law, the courts of this country should make sure that the rights of subjects of other countries are protected by all established safeguards of justice, and especially that they are afforded the "fair and open hearing" which this Court has termed an "inexorable safeguard" (*Morgan* v. *United States*, *supra*).

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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